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**FEB 16 2005**

**OFFICE OF PETITIONS**

**ON PETITION**

In re Application of :  
Sjoblom :  
Application No. 09/423,511 :  
Filed: November 10, 1999 :  
Attorney Docket No. 70324-69523 :

This is a decision on the petition under 37 CFR 1.137(a), filed October 22, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

A final Office action was mailed on March 22, 2004.

An "Applicant Initiated Interview Request Form" was filed on April 16, 2004.

Petitioner states he never received a response to the written request for an interview. The file contains no indication a response was ever mailed to petitioner.

Petitioner contends he made many attempts to schedule an interview but the examiner and the examiner's supervisor failed to return his phone calls.

The MPEP indicates that the grant of an interview is discretionary and an applicant does not have the *right* to an interview after the mailing of a final Office action. An examiner *may* grant an interview if the examiner believes the interview would be beneficial.

MPEP 714.12 states,

Once a final rejection . . . has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. . . . The prosecution of an application before the examiner should ordinarily be concluded with the final action. However, one personal interview by applicant may be entertained after such final action if circumstances warrant.

MPEP 713.09 states,

Normally, one interview after final rejection is permitted. . . . Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration.

The examiner never exercised the option of granting an interview.

An amendment was filed on September 2, 2004, along with a request for a three month extension of time.

The examiner determined the amendment did not *prima facie* place the application in condition for allowance. Therefore, the application became abandoned by statute on September 22, 2004.

An advisory action was not mailed until September 22, 2004, resulting in the advisory action not being received by applicant until the maximum extendable period for reply had passed.

A grantable petition under 37 CFR 1.137(a) must be accompanied by showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable.

The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”<sup>1</sup> The general question asked by the Office is: “Did petitioner act as a reasonable and prudent person in relation to his most important business?”<sup>2</sup>

In a non-provisional application abandoned for failure to reply to a final action, the reply required for consideration of a petition to revive must be:

- (A) a Notice of Appeal (and appeal fee)
- (B) an amendment that cancels all the rejected claims or otherwise *prima facie* places the application in condition for allowance; or
- (C) the filing of a Request for Continued Examination (RCE).

See MPEP 711.03(c)(III)(A)(2).

The record fails to include any indication that petitioner was unable to file a Notice of Appeal or RCE. Petitioner had the option of taking steps that would ensure the application would not become abandoned.

Prior to the last day of the maximum extendable period for reply, petitioner was aware that the examiner had *not* indicated the filed amendment had been entered and the application would be allowed. At this point in time, petitioner had two choices:

- (1) file a RCE or Notice of Appeal and guarantee the application would not become abandoned, or
- (2) take no further action and risk abandonment.

Petitioner voluntarily chose not to take actions which would have eliminated the risk of abandonment. The instant petition contends the abandonment of the application was unavoidable. However, petitioner has not proven that a reasonable and prudent person, treating the application the same as he would treat his most important business, would voluntarily choose a course of action resulting in a risk of abandonment when he could instead choose a course of conduct that would guarantee the application would not become abandoned. The evidence fails to establish the abandonment was unavoidable.

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<sup>1</sup> Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

<sup>2</sup> See In re Mattullath, 38 App. D.C. 497 (D.C. Cir. 1912).

It is regrettable that the Advisory Action was not mailed until the end of the statutory period set for response to the final Office action, however, it is clear from 37 CFR 1.116 that abandonment of an application is risked when an amendment after a final Office action is filed. Petitioner may not rely upon non-receipt of an advisory action to establish that the delay was unavoidable. A delay is not "unavoidable" when an applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. See MPEP 711.03(c)(III)(C)(2).

A delay is not rendered "unavoidable" due to the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action.<sup>3</sup>

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply (already submitted), the required petition fee (\$750 for a small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. A copy of a blank petition form is enclosed for petitioner's convenience.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed, and therefore, must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By facsimile: (703) 872-9306  
Attn: Office of Petitions

If a request for reconsideration is filed, and a decision on the new petition is not received within three months, petitioner may wish to call the number below to check on the status of the renewed petition.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley  
Petitions Attorney  
Office of Petitions

Attached: Form PTO/SB/66

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<sup>3</sup> See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).